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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,589	01/31/2002	Roger Q. Roberts	2860	3409

26822 7590 11/30/2004  
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EXAMINER

HANDY, DWAYNE K

ART UNIT PAPER NUMBER

1743

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/062,589

Applicant(s)

ROBERTS ET AL.

Examiner

Dwayne K Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-25 is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on 9/27/2004. These drawings are approved.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 4-9 and 13-15 were previously rejected under 35 U.S.C. 102(b) as being anticipated by Kedar et al. (6,083,761). This rejection remains in effect and now includes new claims 20-22. Please see Response to Arguments below.

### ***Inventorship***

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 4-6, 10-12 and 16 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Kedar et al. (6,083,761) in view of Harris (4,473,094). This rejection remains in effect and now includes claims 23-25. Please see Response to Arguments below.

***Response to Arguments***

7. Applicant's arguments filed 8/27/2004 have been fully considered but they are not persuasive. In traversing the Examiner's rejections, applicant has relied upon two main arguments: (1) The device of Kedar does not meet the limitation of "flexible" or teach integrally molded valves; and (2) The reference Harris is not analogous art for combining with Kedar. The Examiner respectfully disagrees on both counts.

Applicant has broadly claimed a flexible matt. The only limitation that may be construed as applying to the flexibility of the matt in the specification is a statement that the well plate seal may be made of silicon (paragraph [0026]). Other phrases – such as those present in the same paragraph and in the claims reciting what the flexibility is "for" - are not given patentable weight by the Examiner. This constitutes quite a broad limitation, then.

Webster's College Dictionary (10<sup>th</sup> ed.) defines flexible as "capable of being flexed: pliant" and "yielding to influence: tractable". Given that the wells of Kedar do indeed flex to provide an opening when subjected to a pressure and the fact that the wells and upper portion of the plate are made of the same material, the Examiner believes the upper plate of Kedar meets the broad limitation of "flexible" – it's all the same material and the wells clearly are flexible in the bottom. Applicant has argued that since the device of Kedar may be handled by robotics it is not flexible. This is a spurious argument. This line of argument begs the question: What level of rigidity is required in a structure in order for it to be handled by automated means? Even if the Examiner recognizes that some level of rigidity is required in order for Kedar's device to be handled by the automated machinery, how much rigidity is required before the device

can no longer be considered "flexible"? This is not able to be determined given Kedar's simple disclosure of providing the device with cutouts for using the device with automated means. Therefore, Examiner still feels that Kedar is a "flexible" device given the definitions cited above.

As for the integral valve limitation, the Examiner again refers to Webster's College Dictionary 10<sup>th</sup> ed. which defines a valve as "any of numerous mechanical devices by which the flow of liquid, gas, or loose material in bulk may be started, stopped or regulated by a movable part that opens, shuts, or partially obstructs one or more ports or passageways". The Examiner believes the opening at the bottom of Kedar's wells provides just such a device. The Examiner also again refers to the fact that the wells and upper part of Kedar's plate may be made as one integral piece.

Applicant has argued that Harris is non-analogous art since Harris is drawn to an air outlet. The Examiner considers the valve of Harris to be an improvement upon the valve structure of Kedar. It prevents back flow between two containers – one of which includes a filter element – as in Kedar - through which gas passes and backflow is undesirable. The Examiner believes this to be an important consideration in filtering whether in plates as in Kedar as it is in the Harris patent. Also, duckbill valves are well known within the art as single directional flow controllers.

The Examiner has also rejected the new claims presented with the current amendment. In the base claim (cl. 20), applicant has added "an extraction plate including multiple wells." Giving this limitation it's broadest reading possible, the Examiner believes Kedar meets the limitations of this claim as well. Kedar provides a

lower plate (14) as well as an upper plate (12). The Examiner has used the upper plate (12) to reject the previous claims. The Examiner believes the lower plate (14) anticipates the new element recited by applicant. It is a plate with multiple wells. The terms extraction and separation used in the claim to describe "plate" and wells" describe intended uses of those elements of the device and the language of the claims involving what the plate/wells are "for" have not been given patentable weight. Also, applicant has not claimed any specific structural relationship between the plate and matt. Therefore, the prior art merely needs to provide the element to meet the claim limitation.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH  
November 28, 2004

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center